



30 APR 2007

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In re Application of	:	
EDUARDO DIAZ DEL RIO PEREZ	:	DECISION ON
Application No.: 10/553,663	:	
PCT No.: PCT/IB04/01539	:	PETITION
Int. Filing Date: 16 April 2004	:	
Priority Date: 18 April 2003	:	UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 576391-2003	:	
For: EXPLOSION-INHIBITING ARTICLES OF	:	
MANUFACTURE	:	

This is a decision on petition under 37 CFR 1.47(b), filed 09 November 2006 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing sole inventor, EDUARDO DIAZ DEL RIO PEREZ. Applicant's request for a three month extension of time is granted.

### **BACKGROUND**

On 16 April 2004, applicant filed international application No. PCT/IB04/01539 which claimed a priority date of 18 April 2003, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 28 October 2004.

On 17 October 2005, within 30 months from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee.

On 09 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b) must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 09 November 2006, petitioner filed the instant petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was accompanied by a Statement of David M. McConoughey, regarding inventor Eduardo Diaz Del Rio Perez's refusal to sign the application, a declaration executed by the nonsigning inventor directed to the prior filed provisional application, and a copy of an Agreement executed by inventor Eduardo Diaz Del Rio Perez, which identifies the U.S. priority application.

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied Item (1), with the payment of the required \$200 petition fee charged to Petitioner's deposit account per his authorization.

With regard to Item (2), petitioner is attempting to provide adequate proof that the sole inventor refuses to sign the application. Specifically, Mr. McConoughey's declaration states, and accompanying exhibits demonstrate, that in a 29 September 2006 letter, he requested the nonsigning inventor Diaz Del Rio Perez to execute the declaration for this application. The letter included a copy of the international application and declaration. Thereafter, on 6 November 2006, Mr. McConoughey communicated with the nonsigning inventor's lawyer, Daniel J. O'Connor. Mr. O'Connor indicated that he would "see what he could do with respect to the execution of the declaration by the inventor." No reply from either the nonsigning inventor or his attorney was received. On 9 November 2006, applicant filed the instant petition. Three days is insufficient time to allow the nonsigning inventor's counsel to reach Mr. Diaz Del Rio Perez and confirm his willingness or unwillingness to sign the application. Applicant has not yet satisfied Item (2).

Item (3) is satisfied because Petitioner provided a statement of the last known address of the inventor.

As for Item (4), Petitioner provided a declaration executed by the inventor directed to the provisional application. What is required is a declaration executed on behalf of the nonsigning inventor and identifying the 37 CFR 1.47(b) applicant. Here, the declaration does not fulfill the requirement of 37 CFR 1.497(b) and a newly executed declaration is required which complies with 37 CFR §§1.497(a) and (b) and 1.47(b). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b). The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64. See MPEP §409.03(b) for further details. Item (4) is not yet satisfied.

Regarding item (5), Section 409.03(f) of the MPEP, **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR

1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324)....

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Here, petitioner is attempting to prove that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter to justify filing the application. The assignment, attached to the petition, is between Eduardo Diaz Del Rio Perez and Fusaco IP Sarl. The assignment is defective to prove the proprietary interest because the assignment does not identify the U.S. application at issue, but identifies provisional priority application. Applicant does not demonstrate how this agreement is directed to the above referenced application.

Where there is no written agreement to assign or the invention has not been assigned, petitioner must demonstrate a proprietary interest by an appropriate legal memorandum. No such statement is found for such purpose. As stated above and reiterated here, an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant is required. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. A statement under 37 CFR 3.73(b) by the assignee must also be submitted. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. Item (5) is not satisfied.

As for Item (6), irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party and to prevent irreparable damage. Such statement has been presented (section F of the petition). Thus, item (6) is satisfied.

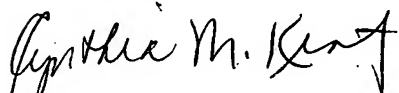
Accordingly, items (2), (4) and (5) above are not satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

### **CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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